

## **REMARKS**

### **Claims**

The final Office Action dated March 24, 2006 rejected claims 1-26 based on U.S. Publication No. 2003/0172116 A1 to Curry *et al.* in view of U.S. Publication 2004/0172451 A1 to Biggs *et al.* In view of the following remarks, reconsideration and prompt early allowance are respectfully requested.

### **Rejections under 35 U.S.C. § 103**

Claims 1-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Curry *et al.* in view of Biggs *et al.* This rejection is respectfully traversed.

Applicant has previously submitted Exhibits A-D along with Declarations from each inventor under 37 C.F.R. § 1.131 to overcome the Office Action's rejection under 35 U.S.C. § 103(a). In submitting the Declarations and Exhibits A-D, the Applicant swears behind the filing date of the Biggs reference, and can attest a prior invention of the claimed subject matter before the filing date of the Biggs reference. The Examiner, however, has found the Declarations and supporting Exhibits to be insufficient to overcome the rejection. Applicant respectfully disagrees.

37 C.F.R. § 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The way for establishing a prior invention that the Applicant relies on is "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent reduction to practice." 37 C.F.R. § 1.131(b).

Exhibit A is submitted to demonstrate evidence to support a date of conception prior to the filing date of the Biggs reference. An actual date of conception is not provided with Exhibit A, however, an actual date of conception is not required:

“When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.” (See MPEP § 715.07).

As demonstrated in Applicant’s Rule 1.131 Declaration, Exhibit A clearly supports the claimed subject matter. Exhibit A contains subject matter that at least supports the independent claims of Applicant’s invention. More specifically, regarding claims 1, 11, and 22, the “Receiving Photos in E-mail” section of Exhibit A describes the idea of receiving a media-enabled message that includes a media object wherein the media object can be selected to present an enhanced representation of the media object. The aforementioned section describes a user receiving an email with links to images. The section continues to state that the user can select and store the images in an Organizer, wherein the Organizer can be used to view the actual images (See “Upsell” section of Exhibit A). Independent claim 17 involves a sender selecting a media object to embed into a media-enabled message and publishing an enhanced representation of the media object to a recipient. This aspect of the invention is disclosed in the “Send and Publish” section on page 1 of Exhibit A. Therefore, when comparing Exhibit A to the independent claims, one of ordinary skill in the art could reasonably discern that

Applicant's claimed invention, in view of the supported sworn Declarations, is fully supported by Exhibit A and was conceived prior to the filing date of the Biggs reference.

Exhibits B and C are provided to show diligence by the inventors in the completion of the invention from a time prior to the filing date of the Biggs reference continuously up to the date of an actual reduction to practice of the invention – which is the “critical period” for establishing diligence outlined in 715.07(a) of the MPEP. The Declarations clearly explain the facts the Applicant is relying on within the Exhibits to establish diligence. The time period between Exhibits B and D, wherein Exhibit D is provided to demonstrate an actual reduction to practice, is about one month. Such diligence by the Applicant is “reasonable” in the particular field of art under the guidelines outlined in 2138.06 of the MPEP. Therefore, one can reasonably determine that the Applicant was diligent just prior to the effective date of the Biggs reference to an actual reduction to practice.

Exhibit D is provided to establish an actual reduction to practice. In the interview conducted by Applicant and the Examiner on April 20, 2006, the Examiner noted that even if conception and diligence could be established with Exhibits A-C, Exhibit D was insufficient in establishing an actual reduction to practice. Applicant respectfully disagrees.

In an interference proceeding, “a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose.” Eaton v. Evans, 204 F.3d 1094, 1097 (Fed. Cir. 2000). Section 715.07 of the MPEP states that the “facts to be

established under 37 CFR 1.131 are similar to those to be proved in interference,” however, the MPEP recognizes that though the facts to be established are “similar” they are not exactly identical. The MPEP cites In re Eickmeyer, 602 F.2d 974 (CCPA) to explain the difference between establishing an actual reduction to practice for a Rule 1.131 affidavit and for an interference proceeding:

The purpose of a [37 CFR 1.] 131 affidavit is not to demonstrate prior invention, per se, but merely to antedate a reference . . . it does not necessarily follow that Rule 1.131 practice is controlled by interference law . . . the parallel to interference found in Rule 131(b) should be recognized as one of convenience rather than necessity . . . Thus, “the ‘conception’ and ‘reduction to practice’ which must be established under the rule need not be the same as what is required in the ‘interference’ sense of those terms.”

It therefore follows that the burden for establishing an actual reduction to practice for a Rule 1.131 affidavit is less than the burden for establishing an actual reduction to practice for an interference proceeding. See Wetmore v. Quick, 536 F.2d 937, 943 (CCPA 1976) (stating “one may antedate a reference by a showing which is less than that which would be required for a party to win a priority contest.”).

In the case of Application of Clarke, 356 F.2d 987, 992 (CCPA 1966), the court presented a reasonable method for determining whether an applicant has established an actual reduction to practice in conjunction with a Rule 1.131 affidavit. The court held:

“In our view, where it can be concluded that facts, offered in a Rule 131 affidavit in support of a general allegation of conception and reduction to

practice of the invention, would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed so much of the invention as to encompass the reference disclosure, then that showing should be accepted as establishing prima facie a case of inventorship prior to the reference, sufficient for the purpose of overcoming the reference in an ex parte case.”

Applicant believes that the Exhibit D meets requirement defined in Clarke, and further believes that the argument can be made that Exhibit D meets the strict requirements for establishing an actual reduction to practice under an interference proceeding. Regarding the requirements under an interference proceeding, Applicant believes that Exhibit D discloses an embodiment that demonstrates every limitation of the independent claims and that the embodiment operated for its intended purpose. Exhibit D is an email that details instructions on how to use the invention with a test tool. The instructions informs the user of specific program code to install and execute on the user’s machine. Claims 1, 11, and 22 involve a recipient receiving a media-enabled message that includes a media object, that when accessed, enables the user to experience an enhanced representation of the media object. Instructions 13 and 14 of Exhibit D disclose the subject matter of these claims. Instruction 13 discloses that links to images are included in a “Photomail,” wherein “Photomail” is the term given to the emails containing the links to the photo images. Instruction 13 further details that a recipient can select a link that starts a slideshow that displays enhanced representations of the corresponding links included in the Photomail. Paragraph 16 of Applicant’s patent

application specification additionally supports the concept that the slideshow is used to present an enhanced representation of the selected media object.

Instructions 7-13 of Exhibit D disclose the subject matter of independent claim 17. Claim 17 involves a sender selecting a media object to embed into a media-enabled message and publishing an enhanced representation of the media object to a recipient. Instruction 8 details a sender selecting some photos to insert into a Photomail, and Instructions 12 and 13 detail how the images are published. For all of the independent claims, the second prong of the two prong test – “the embodiment or process operated for its intended purpose” – is established with Instruction 14 with the statement “click one of the links and enjoy your slideshow!”. This statement clearly indicates that the invention operated for its intended purpose as a user would not be able to enjoy the slideshow if the invention did not operate properly. Exhibit D clearly meets the requirements for establishing an actual reduction to practice under interference standards, and, at the very least, establishes a reduction to practice under the Clarke test as Exhibit D “would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed so much of the invention as to encompass the reference disclosure.” Therefore, Exhibit D makes a sufficient showing that the Applicant actually reduced the invention by the date stated in the Rule 1.131 affidavit.

Moreover, it is understood that the USPTO should generally take sworn statements within an affidavit and accompanied Exhibits referred within the affidavit as being true without requiring any further investigation. Similar to why the MPEP requires the USPTO to take an applicant’s allegation as being true that conception of his invention occurred prior to the filing date of the reference when the applicant omits the date from a

supporting Exhibit, the USPTO is also suppose to take other statements stated in a Rule 1.131 affidavit as being true. In Ex Parte McGuckian, 202 U.S.P.Q. 398, 399 the Examiner determined that an applicant's Rule 1.131 affidavits were insufficient and stated that "it is not seen that applicant's mere statement that he conceived and reduced to practice the disclosed and claimed invention is sufficient to meet the requirements of a Rule 131 showing." The Board of Appeals, however, reversed the Examiner's determination and held:

"We must completely disagree with the Examiner's position. A 131 showing is presented and must be evaluated completely ex parte. It is neither the Examiner's function nor our function under such circumstances to divine the role if any played by someone who is complete stranger to the proceeding. It is only in some inter partes proceeding, totally lacking here, where all interested parties are represented and the fundamental safeguards of direct examination and cross-examination are possible, that the question of inventorship and dates of invention can be explored in the manner attempted by the Examiner here."

The decision in McGuckian only further supports Applicant's position that Exhibits A-D are sufficient to antedate the Biggs reference. Conception prior to the Biggs reference has been established with Exhibit A, reasonable diligence just prior to the filing date of the Biggs reference to an actual reduction to practice has been established with Exhibits B and C, and an actual reduction to practice has been established with Exhibit D. The Office Action, therefore, can no longer maintain a valid rejection under 35 U.S.C. § 103(a) as the Biggs reference does not qualify as prior art. The Curry and

Biggs references in combination fail to present applicable prior art in order to maintain a valid rejection upon claims 1-26. Accordingly, withdrawal of the rejection of these claims under 35 U.S.C. §103 is respectfully requested.

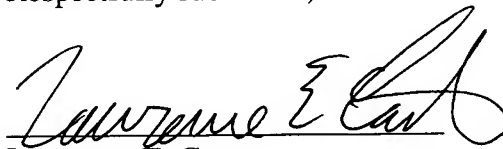
### CONCLUSION

Applicant has duly considered the rejections of claims 1-26 in the Office Action, and responded by the foregoing amendments and remarks. Applicant has thereby even further distinguished the pending claims from the art of record. Applicant therefore respectfully requests timely entry of this Amendment and passing of this application to issue. Should however any issues remain before issuing this application, the Examiner is urged to contact the undersigned to resolve the same. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.108796.

Respectfully submitted,

Date:

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